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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,509	07/17/2000	FUMITAKE YODO	6715/60188	7100

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/600,509

Applicant(s)
Fumitake Yodo

Examiner
Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 21, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, and 7 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Acknowledgments

1. The amendment filed March 21, 2003 (Paper No. 12) is acknowledged. Accordingly, claims 1, 4, 5 and 7 remain pending.

Terminal Disclaimer

2. The terminal disclaimer filed on May 5, 2003 (Paper No. 13) disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of patent application no. 09/923,702 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Restriction

3. In view of the 35 USC § 112 2nd paragraph rejection as stated in the previous Office Action (Paper No. 11), Paragraph No. 4, Applicant has now shifted the scope of the claims from a terminal device to a system. The USPTO however generally does not permit shift. See MPEP §819. In this case, because Applicant has shown a desire for shift as evidenced by the amendment in Paper No. 12, the Examiner will permit shift on the condition that the restriction from Paper No. 4 be withdrawn and at least one terminal disclaimer is filed based on the 09/923,702 application. As noted above, the terminal disclaimer has been filed. Therefore, the restriction in Paper No. 4 mailed January 17, 2002, Paragraphs Nos. 1 and 2 is hereby withdrawn.

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4. In view of the restriction withdrawal and Applicant's various other copending applications including but not limited to Applicant's divisional application(s), Applicant is reminded of his duty of disclosure under 37 C.F.R. §1.56 and other rules with particular emphasis on double patenting issues.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

6. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Peterson, Jr. (U.S. 5,857,020) ("Peterson '020"). Peterson '020 discloses a terminal with a first memory (memory storing 91), a second memory (memory storing 79), a controller (94); a second controller (the digital-to-analog converter within 40); the controller reduces the accounting point information (from 91) stored in the first memory and updates the attributes of the received information from an unavailable state to an available state (decrypts the secured data making it available to the user); if the user has insufficient funds, the data is held in the unavailable state (inherent); the second controller transmits the accounting point information (for an increase in

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funds) and the accounting point information is reset to an initial value (e.g. greater than or equal to \$5) based upon the status of the account processing (payment was received) (inherent in the "automatic online process" at column 9, lines 44-53); and a communicator (40).

7. Functional recitations using the word "for" (e.g. "for storing accounting point information" as recited in claim 1) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). By way of examples only, the Examiner suggests, "a second controller transmitting" as positive recitations removing the language from its current functional interpretation. See the Response to Arguments, *infra*.

8. For due process purposes, the Examiner again notes that Applicant has decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. The Examiner cites three (3) factual findings to support his position. First, after receiving express notice of the Examiner's position that lexicography was *not* invoked,¹ Applicant has *not* pointed out the "supposed errors" in the Examiner's position

¹ See the first Office Action on the merits mailed January 17, 2002, Paper No. 4, Paragraph No. 12; the second Office Action on the merits mailed May 21, 2002, Paper No. 6, Paragraph No. 10; and the third Office Action on the merits mailed December 20, 2002, Paper No. 11, Paragraph

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regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b).² Second and also as stated in the previous office actions, it is again the Examiner's factual determination that not only have Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also *not* pointed to a term or terms in a claim with which to draw in those statements.³ Finally and again as noted in the previous office actions, Applicant has declined the Examiner's express invitation⁴ to be their own lexicographer.⁵ Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d

No. 10.

² *Id.*

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ See Note 6, *supra*.

⁵ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed June 1, 2003).

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1023, 1027 (Fed. Cir. 1997),⁶ and the Examiner continues to rely heavily and extensively on this interpretation.⁷ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4, and 5 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson '020.⁸ It is the Examiner principle position that claims 1, 4, 5, and 6 are anticipated because of the inherencies as noted above. Alternatively, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 to include the missing inherencies. For example, because Peterson '020 directly discloses "automatic online process," at column 9, ~ line 53, one of ordinary skill in the would

⁶ See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁷ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

⁸ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the §102 rejection.

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understand the accounting center must perform at least one “accounting process based upon the accounting point information transmitted from the terminal device.” It is clear to those skilled in the art that if the user had only 16¢ left in his or her account, this amount is transmitted to the accounting center via the “automatic online process” and added to any amount additionally purchased. It is also evident that the server would store the customer’s records in a central location and not just at the terminal device. “The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) citing *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”).⁹

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson ‘020 in view of Goldman (U.S. 5,629,867). Peterson ‘020 discloses as discussed above but does not directly disclose a third controller. Goldman teaches that although only one processor (10) is required, to provide optimum performance, a processor system using two processors (10 and 12) is preferred (column 4, lines 38-45).

⁹ See also *In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970) (“This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art yet unfamiliar to laymen need not be set forth.”).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peterson '020 as taught by Goldman to include a third controller as a redundant processor. Such a modification would have provided redundancy such that if one processor failed, the other processor could immediately take over without interruption.

Moreover, the claimed functions performed by "a third controller" in claim 7 could easily be performed by controller (32) in Peterson '020. Applicant is reminded that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 47 CCPA 771, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).¹⁰ In this case, it is the Examiner's factual determination that duplicating processors (whether its two or three processors) would not produce new or unexpected results other than to increase processing speed.

12. All claimed features in claims 1, 4, 5, and 7 are either disclosed or inherent in the references discussed above.

Response to Arguments

13. Applicant's response filed with his amendment has been fully considered but does not place the claims in condition for allowance.

¹⁰ See MPEP §2144 titled "Legal Precedent Can Provide the Rational Supporting Obviousness ..." for a discussion of how legal precedent can be used as a substitute for a motivational statement in obviousness rejections.

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14. Regarding the combination/subcombination, because Applicant has now unambiguously claimed a system or combination claims, the §112 2nd paragraph rejections on this point have been withdrawn.

15. Applicant has adopted the Examiner's recommendation that the phrase "for transmitting the accounting point information . . ." be given greater patentable weight. Furthermore, the Examiner acknowledges that Applicant now intends to claim the system. While the phrase has been given greater patent because it is now within the claimed system, Applicant has nevertheless retained the "for" language.¹¹

a. As noted above in Paragraph No. 7, the phrase Applicant refers to is still functional language. Additionally, the Examiner acknowledges that there is nothing wrong with functional language in product claims as evidenced by the *lack* of a 35 U.S.C. 112 2nd paragraph rejection. However, for prior art purposes, the claim remains anticipated or obvious because the functional language does not produce a structurally different invention and because the prior art is at least capable of performing the claimed invention.

b. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). In other words, "apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

¹¹ See also e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

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c. Applicant has in effect, attempted to distinguish his claimed invention based upon use since he recites “for” doing a particular task. However Applicant’s machine claim (i.e. claim 1) already covers all uses. The Examiner notes that “the inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.” *Catalina Marketing International Inc. v. Coolsavings.com Inc.*, 289 F.3d. 801, 809, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002) (citations and quotations omitted). Therefore, the Examiner finds that he has considered Applicant’s claimed use.

d. Most importantly, Applicant is reminded that when interpreting functional language, if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (applicant’s popcorn dispenser was anticipated with an oil can because the functional limitations were inherent in the reference). The Examiner agrees with the statement that Peterson ‘020 does not directly disclose the transmission of the accounting point information from the terminal device to the accounting center. However in this case, one of ordinary skill in the art would understand that the “automatic online process” in Peterson ‘020 sufficiently addresses, covers, and/or reads on the functional language at issue. In other words, the Examiner finds that this functional language is inherent since Peterson ‘020 is capable of performing the claimed function. The Examiner also finds that because the claimed function is inherent, a prima facie case of anticipation has been established. Once this prima facie case of anticipation has been established, the burden shifts to the Applicant to show that the prior art structure does not

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inherently possess the functionally defined limitations of his claimed apparatus. *Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432. As of the date of this Final Office Action, Applicant has not successfully rebutted this presumption.

e. After reviewing the claims, the prior art, and all of Applicant's arguments on this matter, the Examiner finds that Applicant's arguments are not persuasive.

16. Regarding claim 7, Applicant only argument is that "there are no features in Goldman that somehow could be combined with Peterson '020 and result in the presently claimed invention"

a. First, whether or not there are some features in Goldman that can be combined with Peterson '020 is immaterial. Second, even if material, Applicant's statement is factually incorrect. For example, one of ordinary skill in the art would clearly understand that the computer monitors in Goldman can be combined with the CPU's in Peterson '020 in to create a standard PC. Therefore, the statement that "there are no features in Goldman that somehow could be combine with Peterson '020" is facially incorrect.

b. Second, since Peterson '020 is relied on by the Examiner only to show a third controller, the other features of Goldman are not at issue and also immaterial.

c. Third, the "somehow be combined" standard is not the standard the Examiner must meet for a conclusion of obviousness. Applicant is reminded that "[o]nly a reasonable expectation of success, not absolute predictability, is necessary for a conclusion of obviousness" *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 652 (Fed. Cir. 1985).

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d. The Examiner finds that in accordance with 37 C.F.R. §1.111(b), Applicant's response doesn't "point out the specific distinctions believed to render the claims . . . patentable over any applied references." The Examiner also finds that with respect to claim 7, Applicant's arguments do not point out *a single feature* that renders his claims either not anticipated or nonobvious when compared with the prior art.

e. After reviewing claim 7, the prior art, and all of Applicant's arguments on this matter, the Examiner finds that Applicant's arguments are not persuasive.

Additional Confirmations

17. In an effort to keep this Office Action complete as practically possible and because of the numerous office actions in this application, the following additional confirmations from the previous office actions are again briefly noted by the Examiner. The following list is not meant to be by any means exhaustive.¹² Moreover, because Applicant has not pointed out the "supposed errors" in accordance with 37 C.F.R. §1.111(b)—during the remaining ex parte examination process—the following additional findings and/or conclusions are considered admissions upon

¹² Evidence to support the Examiner's position that this list is not meant to be exhaustive includes the preceding statements in this Office Action including but not limited to the prior art rejections and the Examiner's statement(s) on claim interpretation issues. Additional evidence includes the prior office actions; Applicant's amendments, remarks, and responses; and the fact that the Examiner titled these confirmations as "*Additional*."

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which the Examiner relies.¹³ Because of these admissions and subsequent reliance, the Examiner will not provide any additional evidence or arguments on these matters:

a. Applicant has not separately pointed out the patentable features in claims 4 and 5 in accordance with 37 C.F.R. §1.111. Therefore, as currently claimed, the patentability of claims 4 and 5 stands or falls together with the patentability of claim 1.

b. 35 U.S.C. 112 6th paragraph is not invoked in any pending claim. See the previous office actions beginning with the previous Office Action on the merits mailed December 20, 2002, Paper No. 11, Paragraph No. 8.

c. "Preponderance of the evidence is the standard that must be met by the PTO in making rejections." *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994)(citations and quotations omitted). See the Office Action mailed December 20, 2002 (Paper No. 11, Paragraph No. 16).

d. "A system is an apparatus." *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907).

Therefore, it is the Examiner's position that Applicant's system claims are "product" "apparatus,"

¹³ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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or more specifically, "machine" claims.¹⁴ See also the Office Action mailed December 20, 2002 (Paper No. 11), footnote 5.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20. Unless expressly noted otherwise by the Examiner, the following two citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations within this Office Action are from the MPEP 8th Edition, August 2001.

¹⁴ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

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21. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (e.g. prior art) and expressly noted their content, this does *not* mean that the other documents of record were not contemplated when making the prior art rejections above. Moreover, because the canons of claim construction are generally viewed from a person of ordinary skill in the art,¹⁵ the other documents of record not specifically mentioned in the prior art rejections above were—at the very least—used in the Examiner’s deliberative process to assess, inter alia, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

22. Because this application is now final, Applicant is also reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and

¹⁵ See e.g. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

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enablement, §112 2nd paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.

23. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner cites How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla as additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Since the references are directed towards beginners, the references are primarily directed towards those of *low* skill in the art. Therefore, one of *ordinary* skill in the art must—at the very least—be aware of the knowledge contained within the references. The Examiner has provided Applicant with copies of selected sections including the table of contents, indexes, and/or Parts of the references.

24. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (Paper No. 12 beginning on page 5) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made

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by the Examiner in this Office Action whether expressly stated or implied¹⁶, the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next properly filed response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

AJFischer 6/1/03
ANDREW J. FISCHER
PATENT EXAMINER

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AJF
June 1, 2003

¹⁶ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.